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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,756	10/16/2000	Fatih M. Uckun	12152.76USD1	1604

23552 7590 01/25/2002

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER	
LIU, HONG	

ART UNIT	PAPER NUMBER
1624	7

DATE MAILED: 01/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/688,756	Uckun et al.
Examiner	**Art Unit**
Hong Liu	1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 30-35 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 30-35 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Claims 30-45 are pending in this application.

Election/Restriction

Applicants's election of Group II, claims 30-35 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claim 36-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Myers et al. (WO 95/15758). Myers teaches the use of the 6,7-dimethoxy quinazoline compounds in the treatment of inflammatory response (see examples). While the reference does not mention UVB-radiation-induced inflammatory response, following the teachings of Myers, one would administrate to a host an instant drug that targets at CSF-1R receptor to treat inflammation and thus inherently performs the same function as claimed herein. See Ex parte Noviski 26 USPQ 2d

1389 as well as the more recent decision, Integra Life Science v. Merck 50 USPQ 2d 1846 in which patent claims were drawn to "a method of inhibiting animal cell proliferation" by contacting a Arg-Gly-Asp peptide with the cell. The reference showed that the same peptide did interfere with the attachment of rat normal kidney fibroblast cells to the fibronectin-coated substrates. Later research established that the inhibition of cell proliferation arises from this effect. While the patentee argued that their original 45 minute experiments were not long enough to observe actual inhibition of cell proliferation, the Court held that "the fact remains that plaintiffs, by publishing the Nature article, publicly revealed the scientific method and by which RGD peptides inhibit the attachment of cells to certain substrates, which by logical extension, also inhibits cell proliferation."

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (WO 95/15758). The reference teaches the use of a generic group of compounds which embraces applicant's instantly claimed compounds. See formula I, Col. 4 wherein R6 and R7 can be methoxy, X can be O, S, N, and C, etc. The compounds are taught to be useful as anti-

inflammatory agents. The claims differ from the reference by reciting a specific species and/or a more limited genus than the reference. However, it would have nevertheless been obvious to one skilled in the art at the time of the invention to be motivated to select any of the species of the genus taught by the reference including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the specie of the genus would have similar properties and, thus, the same use as taught for the genus as a whole, i.e., anti-inflammatory agents. Although the reference dose not specifically disclose the use of the compound to inhibit PGE2, it is well known that PGE2 is an important inflammatory mediate. Since the quinazoline compound can be used to treatment inflammation, one would expect that it would be effective to inhibit PGE2 production as well. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. See *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. V. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In claims 30-32, instant claim language embraces disorders not only for treatment but also for PREVENTION which is not remotely enabled. It is presumed in the prevention of disease and/or disorders claimed herein there is a way of identifying those people who may develop edema, vascular permeability, etc. There is no evidence of record which would enable the skilled artisan in the identification of the people who have the potential of becoming afflicted with the disorders claimed herein.

4. Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
January 23, 2002

Mukund J. Shah

Mukund Shah
Supervisory Patent Examiner
Art Unit 1624